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Filing date: **05/19/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058992
Party	Defendant Karen Millen Fashions Ltd.
Correspondence Address	KAREN MILLEN FASHIONS LIMITED THE TRIANGLE STANTON HARCOURT, INDUSTRIAL ESTATE WITNEY OXFORDSHIRE, EC4A 3WA UNITED KINGDOM
Submission	Answer
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Signature	/mk/
Date	05/19/2014
Attachments	Answer (92058992, KAREN MILLEN).pdf(644864 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Trademark Registration No. 3,469,389

KAREN MILLEN,

Petitioner,

v.

KAREN MILLEN FASHIONS LTD.,

Registrant.

Cancellation No. 92058992

Mark: KAREN MILLEN

Filed: June 28, 2005

Registered: July 15, 2008

**ANSWER TO PETITION FOR CANCELLATION**

Registrant Karen Millen Fashions Ltd. (“Karen Millen Fashions” or “Registrant”), by and through its undersigned attorneys, hereby answers the Petition for Cancellation in the above-identified proceeding. Registrant’s responses to the allegations of Petitioner Karen Millen (“Petitioner”) are based upon actual knowledge of its own actions and information and belief with respect to all other matters. The paragraph numbers hereof correspond to those in the Petition for Cancellation.

1. Registrant denies that the public and trade associate the KAREN MILLEN mark with Petitioner. Registrant further states that Petitioner conveyed to Registrant’s predecessors-in-interest all rights, title, and interest in the KAREN MILLEN name and trademark, including without limitation, the right to use and file trademark applications for marks incorporating Petitioner’s name in exchange for a substantial sum of money. After acquiring those rights, Registrant invested substantial time, money, and effort promoting the KAREN MILLEN mark

and other marks incorporating the KAREN MILLEN name (collectively, “KAREN MILLEN Marks”), and its U.S. retail stores and women’s fashion apparel products bearing the same. As a result of its efforts and fame in the marketplace, the public has come to associate goods sold in connection with the KAREN MILLEN Marks as originating with Registrant. Registrant, through its predecessors-in-interest, has used the KAREN MILLEN Marks in the United States at least as early as 2002. Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 1 of the Petition for Cancellation and, therefore, denies the same.

2. Admitted that Petitioner designed a line of women’s fashion apparel products, and that she participated in the founding of Karen Millen Limited (henceforth, “KML”). Registrant denies that Petitioner sold any women’s fashion apparel products in the United States. KML, with written consent to use and file trademark registrations incorporating Petitioner’s name, began selling KAREN MILLEN branded women’s fashion apparel in the United States in 2002. Registrant, and its predecessors-in-interest, acquired all of Petitioner’s rights and interest in KML, and have made significant and continuous use of the KAREN MILLEN trademark in the United States in connection with women’s fashion apparel and related goods and services. Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 2 of the Petition for Cancellation and, therefore, denies the same.

3. Admitted.

4. Registrant admits that Petitioner executed the consent attached to the Petition for Cancellation as Exhibit A (the “Consent”), but denies that such consent was limited to U.S.

Trademark App. Serial No. 76/129,319. When Ms. Millen executed the Consent, she purposefully did not limit it to a specific application or filing date. Registrant further denies that Petitioner did not convey written consent for the right to file any and all trademark applications incorporating her name. Since at least as early as September 2000, Petitioner owned a substantial interest in KML. As shareholder and officer of KML, Petitioner directly participated in the filing of at least one U.S. Trademark Application in connection with the Karen Millen Marks. Petitioner granted express written consent to KML to file U.S. trademark applications incorporating her name, and, in her capacity as “owner” of KML, continued to prosecute and personally sign documents through at least 2003. *See, e.g.*, Petition to Cancel, Exhibit A; *see also* Statement of Use for U.S. Trademark App. Serial No. 76/129,319, attached hereto as Exhibit A. In a 2004 “buy out” agreement, Registrant, by and through its predecessors-in-interest, acquired Petitioner’s full rights and ownership interest in KML and the KAREN MILLEN Marks in exchange for a substantial sum of money (henceforth, the “Buy Out Agreement”). Petitioner personally executed the Buy Out Agreement. In addition to the sale of her ownership rights in KML, Petitioner also conveyed by written consent to Registrant’s predecessor-in-interest the right to use and file trademarks bearing her name, and agreed not to use the KAREN MILLEN Marks or her name in subsequent business ventures. Therefore, Petitioner conveyed to Registrant’s predecessor-in-interest by written document her share in the trademark rights listed in the Buy Out Agreement. These rights include the right to register the mark KAREN MILLEN and related marks in the United States, which necessarily implies her consent to the use and registration of her name. Indeed, the Trademark Trial and Appeal Board has found such consent in analogous situations in *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985) and *In re VITAFLEX Dr. Walter Mauch GmbH*, 2002 WL 1492637 (TTAB 2002).

5. Registrant admits that U.S. Trademark App. Serial No. 78/660,246 matured into U.S. Trademark Reg. No. 3,469,389.

6. Registrant admits that the KAREN MILLEN mark incorporates Petitioner's name. Registrant denies that consent for Registrant's KAREN MILLEN mark was not conveyed to Registrant by Petitioner. Petitioner conveyed written consent to KML to use and file trademarks bearing her name, and personally oversaw the filing of these applications. As set out in Paragraph 4 herein, Petitioner sold her ownership in KML in a Buy Out Agreement, and relinquished control over the use of her name in connection with the KAREN MILLEN Marks in exchange for a substantial sum of money. Until her recent petition for cancellation for the KAREN MILLEN mark and other related marks, Petitioner had not opposed any U.S. trademark application or registration owned by Registrant. Moreover, Registrant's statutory and common law rights to the KAREN MILLEN Marks, including KAREN MILLEN, are superior to any alleged rights in those marks claimed by Petitioner.

7. Registrant admits that U.S. Trademark App. Serial No. 79/048,901 was filed on February 13, 2008, and went abandoned on September 11, 2009. Registrant denies Petitioner's implication that the aforementioned application was abandoned because of an alleged defect in Registrant's rights to the claimed mark.

8. Registrant admits that the KAREN MILLEN mark incorporates Petitioner's name and is governed by Section 2(c) of the Lanham Act, 15 U.S.C. § 1052, but denies that Petitioner never granted her written consent to Registrant to file and maintain any and all trademark registrations incorporating her name. On the contrary, the consent attached to the Petition for

Cancellation, is expressly and on its face, not limited to a specific trademark application or filing date.

9. Denied. Petitioner received a substantial sum of money in consideration for her ownership interest in KML, the KAREN MILLEN Marks, and her agreement not to use the KAREN MILLEN Marks or her name. Petitioner, through its filing of this and other cancellation proceedings and recent filing of trademark applications covering the KAREN MILLEN mark, now seeks to improperly reap the benefits of Registrant's hard-earned reputation and goodwill that it developed in connection with the KAREN MILLEN Marks after Petitioner relinquished control over them.

### **DEFENSES**

1. The Notice of Cancellation fails to state a claim upon which relief can be granted.
2. Petitioner has relinquished control to any alleged rights in the KAREN MILLEN Marks.
3. Petitioner has consented to Registrant's use and registration of her name by express and/or implied consent.
4. Petitioner has no rights in the United States to the KAREN MILLEN Marks.
5. Registrant's trademark rights in the KAREN MILLEN mark are superior to any rights Petitioner could ever claim to the KAREN MILLEN mark.
6. Petitioner is barred from any relief under the doctrines of estoppel, acquiescence, waiver and/or unclean hands.

Any allegation not specifically addressed herein is denied.

WHEREFORE, Applicant prays that this Cancellation proceeding be dismissed and that registration of Applicant's mark issue pursuant to the application.

Respectfully submitted,

KENYON & KENYON LLP

Dated: May 19, 2014

By: 

Michelle Mancino Marsh  
Michael Kelly  
One Broadway  
New York, New York 10004  
(212) 425-7200

*Attorneys for Registrant  
Karen Millen Fashions Ltd.*

# **EXHIBIT A**



IN THE UNITED STATES PATENT OFFICE AND TRADEMARK OFFICE

In re application of : Karen Millen  
Serial No. : 76/129,319  
Filing Date : 09/18/00  
Mark : **KAREN MILLEN**  
Docket No. : 2201.001

SUBMISSION OF STATEMENT OF USE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

I hereby certify that this documentation is being sent  
via First Class Mail in an envelope to Comm. Of  
Trademarks, Arlington, VA 22202, this 25<sup>th</sup>  
Day of September, 2003, by Karen Millen

Sir:

Applicant is submitting herewith the Statement of Use and examples showing use for the above-identified trademark, Serial No. 76/129,319.

The undersigned authorizes the Office to charge the filing fees in the amount of \$200.00 (2 classes) to McHale & Slavin Deposit Account No. 13-0439.

It is respectfully requested that the Statement of Use is entered, and that the application will proceed to registration.

McHALE & SLAVIN, P.A.  
2855 PGA Blvd.  
Palm Beach Gardens, FL 33410  
PH# 561-625-6575; FAX# 561-625-6572  
[palmbeach@m spatents.com](mailto:palmbeach@m spatents.com)

Respectfully submitted,

Michael A. Slavin  
Pat. Reg. No. 34,016



09-29-2003

**~TRADEMARK/SERVICE MARK ALLEGATION OF USE (Statement of Use/  
Amendment to Allege Use) (15 U.S.C. § 1051(c) or (d))~**

~To the Assistant Commissioner for Trademarks~

**<TRADEMARK/SERVICEMARK INFORMATION>**

<Mark> KAREN MILLEN  
<Serial Number> 76/129,319

**<APPLICANT INFORMATION>**

<Name> Karen Millen Limited  
<Street> Maidstone Business Centre, St. Peter Street  
<City> Maidstone, Kent  
<State>  
<Country> United Kingdom  
<Zip/Postal Code> ME15 OST

**<NOTICE OF ALLOWANCE INFORMATION>**

<Notice of Allowance> **yes** ~Enter YES if you are filing the Allegation of Use **after** a Notice of Allowance has issued. If not, enter NO.~

**<GOODS AND/OR SERVICES INFORMATION>**

<All Goods and/or Services in Application/Notice of Allowance>~The owner is using or using through a related company the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance. If not, list in the next section the goods and/or services not in use to be deleted.~

<Goods and/or Services Not in Use to be Deleted>~In the following space, list only those goods and/or services (and/or entire class(es)) appearing in the application or Notice of Allowance for which the owner is **not** using the mark in commerce. **LEAVE THIS SPACE BLANK IF THE OWNER IS USING THE MARK ON OR IN CONNECTION WITH ALL THE GOODS AND/OR SERVICES LISTED IN THE APPLICATION OR NOTICE OF ALLOWANCE.**~

**<USE INFORMATION>**

<Date of First Use Anywhere> 08/01/2002  
<Date of First Use in Commerce> 08/28/2002

**<OPTIONAL - REQUEST TO DIVIDE INFORMATION>**

<Request to Divide> ~Enter YES if you are submitting a request to divide with this document. If not, enter NO.~

**<FEE INFORMATION>**

\$100.00 x <Number of Classes> 2 = <Total Fees Paid> \$200.00

**<SPECIMEN AND SIGNATURE INFORMATION>**

*~Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

**(You MUST ATTACH A SPECIMEN showing the mark as used in commerce for at least one product or service in each international class covered.)**

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.~

~Signature~

<Date Signed> 3/9/03

<Name> Karen Millen

<Title> Owner

**<CONTACT INFORMATION>**

<Name> Michael A. Slavin

<Company/Firm Name> McHale & Slavin, P.A.

<Street> 4440 PGA Blvd., Suite 402

<City> Palm Beach Gardens

<State> FL

<Country> US

<Zip/Postal Code> 33410

<Telephone Number> (561) 625-6575

<Fax Number> (561) 625-6572

<e-Mail Address> palmbeach@m spatents.com

**<CERTIFICATE OF MAILING> ~Recommended to avoid lateness due to mail delay.~**

~I certify that the foregoing is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on~

<Date of Deposit> 9/24/03

~Signature~

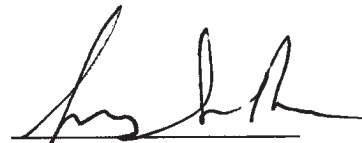
<Name> Cathy Nicholson



**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing *ANSWER TO PETITION FOR CANCELLATION* was served by first class mail, postage prepaid, on this 19th day of May, 2014, at the following address:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Ave.  
New York, NY 10022

  
\_\_\_\_\_  
Jeremy S. Boczko